

REMARKS

Claims 1-24 are pending in the application.

Claims 1-24 have been rejected.

Claims 1-24 remain pending in this application.

Reconsideration of the claims is respectfully requested.

CLAIM REJECTIONS -- 35 U.S.C. § 103

Claims 1-18 and 20-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0145979 to *Baj* (hereinafter “Baj”) in view of U.S. Patent No. 7,173,910 to *Goodman* (hereinafter “Goodman”). The Applicants respectfully traverse the rejection.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Baj in view of Goodman, and further in view of U.S. Patent Publication No. 2002/0114317 to *Dorenbosch, et al.* (hereinafter “Dorenbosch”). The Applicants respectfully traverse the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed.

Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

The Applicants respectfully submit that the cited references fail to teach or suggest all the claim limitations of Claim 1. Specifically, Claim 1 recites, “a test controller configured to receive a test call initiation message directed to the test controller from an originating terminal, to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on the test call initiation message.”

- Having a gatekeeper route a call that is directed to a specified destination phone is not the same as receiving a test call initiation message directed to the gatekeeper.

The Office Action continues to suggest that the gatekeeper 14 of Baj reads on the claimed test controller and that the VoIP client 21 reads on the claimed originating terminal. However, as correctly noted on Page 2 of the Office Action, the gatekeeper 14 of Baj **routes** incoming VoIP calls **to a specified destination**. Specifically, the VoIP calls are directed to a destination phone 24.

Paragraph [0039] of Baj, for example, states:

[0039] Referring to FIG. 3, a process 30 for testing voice quality of VoIP network 10 is shown. VoIP client 21 initially sends (31) a request **to the destination phone 24** to establish a transmission path between the VoIP client 21 and destination phone 24. The request is **routed by gatekeeper 14** and forwarded by gateway 13 to destination phone 24. (Emphasis added by the Applicants.)

Paragraph [0039] of Baj clearly establishes that the VoIP calls are not directed to the gatekeeper 14 as recited in Claim 1. The gatekeeper 14 merely routes the calls directed to the destination phone 24.

Having a gatekeeper route a call that is directed to a specified destination phone is not the same as receiving a test call initiation message directed to the gatekeeper.

The only rebuttal or counterargument to this assessment of gatekeeper 14 is found on Page 2 of the Office Action which suggests, “the test call is sent to the gatekeeper”. The Applicants respectfully submit that simply because a test call is sent to the gatekeeper does not mean that the test call is directed to the gatekeeper. The Applicants respectfully request that all limitations of the claimed invention be considered when determining patentability.

- As correctly noted in the Office Action, the initiator test probe of Goodman initiates a test call. The initiator probe of Goodman does not receive a test call initiation message directed to the initiator probe.

As an alternative, the Office Action now appears to suggest that a phone number is used by an initiator test probe, i.e., test controller, to initiate a test call to the other test probe. However, the Applicants respectfully submit that the test controller of Claim 1 is configured to receive a test call initiation message directed to the test controller, not initiate a test call to another test probe.

- The test tool 22 of Baj simply retrieves audio files and plays them. The test tool 22 of Baj does not prompt the telecommunication device to allocate one of the voice paths within a telecommunication device for a test call based on a test call initiation message.

The Office Action previously suggested that the test tool 22 of Baj reads on the claimed test

controller. However, Paragraphs [0029] and [0030] of Baj, for example, describe the test tool 22 as follows:

[0029] Transmissions of voice information as described above involve a number of devices that contain hardware modules or run software clients. Any problem in these hardware modules and software clients can impair voice quality or disrupt service of the voice transmissions. To ensure the QoS of the voice transmissions, a client server 20 including a test tool 22 is connected to PC 29, either indirectly via Internet 11 as in FIG. 1, or directly as shown in FIG. 2. Test tool 22 receives commands from PC 29 to perform test procedures as will be discussed in detail below.

[0030] Referring now to FIG. 2, client server 20 also includes a memory 201 for storing audio files, which are data files in a digital audio format that can be played by an audio playing device residing on test tool 22. When commanded by a VoIP client 21 that runs on PC 29, test tool 22 retrieves an audio file from memory 201 and plays it. The audio file is played in a call placed by VoIP client 21.

Accordingly, the test tool 22 of Baj simply retrieves audio files and plays them. The test tool 22 of Baj does not prompt a telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on a test call initiation message. Therefore, the test tool 22 of Baj cannot be considered to read on the claimed test controller.

Page 3 of the Office Action indicates that the Examiner does not agree with this assessment of the test tool 22 of Baj. However, the Office Action's response to this assessment merely restates the previous rejection of Claim 1 based upon Baj. The Office Action does not provide any rebuttal or counterargument to this assessment of gatekeeper 14. Again, the Applicants respectfully request that all limitations of the claimed invention be considered when determining patentability.

- Baj does not disclose a test call origination message as recited in Claim 1.

The first full paragraph on Page 4 of the previous Office Action dated August 11, 2008, states, “Baj discloses all of the subject matter except a test call origination message.” The Office Action attempted to cure this deficiency in the teaching of Baj by suggesting that it is obvious to have a terminal generating a test call to the test controller in the test environment of Baj. The suggested motivation for doing so is to use an established configuration for VoIP communications.

Firstly, as established above, the VoIP calls of Baj are directed to the destination phone 24, and there is no reason for the VoIP client 21 of Baj to direct the VoIP calls to the gatekeeper 14 instead. Secondly, the Applicants are unable to understand how having the VoIP calls directed to the gatekeeper 14 would result in using an established configuration for VoIP communications more so than having the VoIP calls directed to the destination phone 24.

Page 4 of the Office Action indicates that the Examiner disagrees with the Applicants’ statement that Baj does not disclose a test call origination message. However, the Office Action’s response to this assessment merely restates the previous rejection of Claim 1 based upon Baj. The Office Action does not provide any rebuttal or counterargument to this assessment.

- The test calls of Goodman are not test call origination messages in that voice paths within a telecommunication device are not allocated based on the test calls of Goodman.

The Office Action also attempted to cure this deficiency in the teaching of Baj by suggesting that Goodman “discloses an initiator test probe initiating a test call by dialing a phone number to the

other test probe by having the call received at the VoIP gateway, i.e., test controller, which directs the call over the VoIP network, using VoIP protocols such as H.323, SIP and MGCP.” However, like the gatekeeper 14 of Baj, the VoIP gateway of Goodman simply routes VoIP calls over the network. The test calls generated by the initiator test probe are directed to another test probe, not the VoIP gateway. Furthermore, the test calls generated by the initiator test probe in Goodman are simply that, test calls. The test calls of Goodman are not test call origination messages in that voice paths within a telecommunication device are not allocated **based on** the test calls of Goodman. Again, the Applicants respectfully request that all limitations of the claimed invention be considered when determining patentability.

Page 5 of the Office Action indicates that the Examiner disagrees with the Applicants’ statement that Goodman does not disclose a test call origination message. However, the Office Action’s response to this assessment merely restates the previous rejection of Claim 1 based upon Goodman. The Office Action does not provide any rebuttal or counterargument to this assessment.

Accordingly, Baj, alone or in combination with Goodman, does not disclose a test call origination message.

Therefore, for all of the reasons established above, the Applicants respectfully submit that neither Baj nor Goodman, individually or in any combination thereof, teaches or suggests a test controller configured to receive a test call initiation message directed to the test controller from an originating terminal, to prompt the telecommunication device to allocate one of the voice paths within the telecommunication device for a test call based on the test call initiation message.

Independent Claims 9 and 20 recite limitations analogous to the novel limitations emphasized above in traversing the rejection of Claim 1 and, therefore, also are patentable over the cited references. Additionally, Claims 2-8, Claims 10-18 and Claims 21-24 depend from Claims 1, 9, and 20, respectively, and include all the limitations of their respective base claims. As such, Claims 2-8, 10-18, and 21-24 also are patentable over the cited references.

Accordingly, the Applicants respectfully request that the Examiner withdraw the § 103 rejection with respect to Claims 1-18 and 20-24.

Claim 19 depends from Claim 9 and includes all the limitations of Claim 9. As such, Claim 19 also is patentable over the cited references. Accordingly, the Applicants respectfully request that the Examiner withdraw the § 103 rejection with respect to Claim 19.

CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining Claims in the Application are in condition for allowance, and respectfully request an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, LLP



John T. Mockler
Registration No. 39,775

ate: September 28, 2009

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *jmockler@munckcarter.com*